



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/665,899

09/18/2003

Brian T. Worsham

25343/37:7

7026

32642 7590 11/13/2008

STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

EXAMINER

NGUYEN, THUY-VI THI

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,899	Applicant(s) WORSHAM ET AL.	
	Examiner THUY VI NGUYEN	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-35, 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on October 07, 2008, wherein:

Claims 19-35, 37 are currently pending;

Claims 19-20, 23, 25-26, 29-30, 32 and 37 have been amended;

Claims 36 have been cancelled;

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2008 has been entered.

Claims Status

3. As of 10/07/08, independent method claim 19 is amended as followed:

19. A computer-implemented method of returning customized information from a database in response to requests about a specific tangible object having attributes, the method comprising:

a) receiving at a computer a first request from a first venue for information on the specific tangible object in inventory;

b) reading a representation of the tangible object from the database, the representation including attributes of the tangible object;

Art Unit: 3689

c) applying a first rule associated with the first venue to the representation of the tangible object to generate a first view of the specific tangible object, the first view including only attributes in compliance with the first rule;

d) returning the first view to the first venue

e) receiving at the computer a second request from a second venue for information on the specific tangible object

f) applying a second rule associated with the second venue to the representation of the tangible object to generate a second view of the specific tangible object, the second view including only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view; and

g) returning the second view to the second venue

4. Note:

1) in step (c), the phrase "*to generate a first view of the specific tangible objectwith the first rule*" is not a positive recited method step but merely intended use of the applied first rule on the first venue and thus having no patentable weight.

2) in step (f), the phrase "*to generate a second view of the specific tangible objectwith the first view*" is not a positive recited method step but merely intended use of the applied second rule on the first venue and thus having no patentable weight.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-24 (method), 25-31 (method), and 32-35 and 37 (method) rejected under 35 U.S.C. 103(a) as being unpatentable over BONNEAU ET AL (US 6,978,273).

Herein after is referred as Bonneau

As for claim 19, Bonneau discloses a method of returning information in response to requests about a specific tangible object having attributes, the method comprising:

a) receiving at a computer a first request from a first venue for information on the specific tangible object in inventory

{see col. 5, lines 3-5 "...the buyers ...inquiries are received", which reads over "a first request" from a "first venue", col. 4, lines 25-32; col. 6, lines 54-59; figures 1-2 and 5c};

b) reading a representation of the tangible object from the database, the representation including attributes of the tangible object;

{see Figs. 1, 2, 3a and 3b, and 6f, 6g}

c) applying a first rule associated with the first venue to generate a first view of the specific tangible object, the first view including only attributes in compliance with the first rule;

{see col. 9, lines 21-67; figures 5a (step 50), 5b-5c,6b ; e.g...generate in accordance with a set of rules that defines the scope of the content of the custom catalog (abstract); i.e. using the rule to search for all software that is manufactured by Microsoft Corporation only, then the view will be generated with this particular Windows NT, 95, 2000 information and exclude other vendor];

d) returning the first view to the first venue { figure 5c (step 584); col. 11, lines 36-43...returns custom catalog database for the buyer];

e) receiving at the computer a second request from a second venue for information on the specific tangible object;

{see col. 5, lines 3-5 "...the buyers ...inquiries are received", which reads over "a second request" from a "second venue", col. 4, lines 25-32; col. 6, lines 54-59; figures 1-2 and 5c};

f) applying a second rule associated with the second venue to the representation of the tangible object to generate a second view of the specific tangible object, the second view including only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view

{see col. 9, lines 21-67; figures 5a(step 50); 5b-5c; 6b "...generate in accordance with a set of rules that defines the scope of the content of the custom catalog (abstract);); i.e. using the rule to search for all software that is manufactured by Microsoft Corporation only, then the view will be generated with this particular Windows NT, 95, 2000 information and exclude other vendor; if search is furthered narrow using

Art Unit: 3689

set of rules by excluding Window 95, then other view will be generated without showing the Window 95;]; and

g) returning the second view to the second venue [...returns custom catalog database for the buyer; figure 5c (step 584); col. 11, lines 36-43].

BONNEAU ET AL fairly teaches the claimed invention except for explicitly indicates the use of a first rule associated with the first venue to generate a first view and a second rule associated with the second view to generate a second view. However, as indicated on col. 5, lines 1-57, BONNEAU ET AL discloses the applying of a set of rules (plurality of rules) to each request per each venue in order to generate different representations for a plurality of different buyers with different requests and levels, it would have been obvious to select /use a first rule associated with the first venue to generate a first view and a second rule associated with the second view to generate a second view because there are different types buyers requesting different products and different levels of buyer-seller relationships as mentioned earlier.

Note: this is a computer-implemented method or “data processing”, so that terms such as “attributes” or “rules”, “view”, or “specific tangible objects”, etc., are considered as non-functional descriptive material (NFDM) and may not have any patentable weight. See MPEP 2106.01.

As for claim 20, Bonneau discloses receiving attributes corresponding to the .specific tangible object; and storing attributes corresponding to the specific tangible object in a database [...col. 4, lines 28-43; figure 3a-b; 5c (step 584)].

As for claim 21, which describes the specific function of the object or data stored in the database, i.e. an automobile, this is non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently in Bonneau as shown in the catalog product database; (abstract). Moreover,

As for claim 22, Bonneau discloses wherein the venues are websites accessible by users at remote locations [figures 1-2];

As for claim 23, Bonneau discloses attributes is an identifier [col. 4, lines 36-44 and figures 3a-b]; The claim deals with well known communication parameter such as from multiple users , this is taught in Fig. 2 and 5a (step 54). The specific steps of receiving a request and applying a rule is taught above. Moreover, the duplicate of services or steps for multiple effects are well known and would have been obvious to a skilled artisan. See In re Harza, 124 USPQ 378, CCPA 1960.

As for claim 24, Bonneau discloses wherein the first view includes the first value and excludes the second value in compliance with the first and the second view includes the second value and excludes the first value in compliance with the second rule [...col. 9, lines 21-67; figures 5a,b,c].

As for independent method claim **25**, which is the combination of independent method claim 19 and 20, it's rejected for the same reason set forth in the rejection of claims 19 and 20 above. Further more, the first limitation which recites "storing a first attribute having first and second values in a database" is non-functional descriptive material which carries no patentable weight.

As for dep. **claims 26-30**, which basically have the same limitation as in dep. claims 20-24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-24 above.

As for independent method **claim 32**, which is the combination of independent method claims 19 and further limitations of receiving requests about objects and applying a multiple of rules (second rule or third rule or fourth rule) for each venue. The duplicate of features (tangible objects) or steps (using two rules for each venue) for multiple effects is well known and would have been obvious to a skilled artisan if duplicate effects are desired. See *In re Harza*, 124 USPQ 378, CCPA 1960.

As for dep. claims **33-35**, which deal with basically have the same limitation as in dep. claims 20-22 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-22 above.

As for dep. claim **37**, which deals with applying a multiple of rules (second rule or third rule or fourth rule) for each venue, the duplicate of step or feature (rule) for multiple effects is well known and would have been obvious to a skilled artisan if duplicate rule effects is desired. See *In re Harza*, See *In re Harza*, 124 USPQ 378.

Response to Arguments

6. Applicant's arguments with respect to claims 19-37 have been considered but are moot in view of the new claims interpretations with respect to the intended use of the phrase (i.e. "to generate....") as shown on paragraph no. 4 above and new ground(s) of rejections. Note that in independent method claim 32, the claim include multiple requests about specific multiple tangible objects having attributes therefore, the generated views will be multiple and have at least one different attributes and taught by Bonneau. Note also that in independent method claim 19, this is a computer-implemented method or "data processing", so that terms such as "attributes" or "rules", "view", or "specific tangible objects", etc., are considered as non-functional descriptive material (NFDM) and may not have any patentable weight.

Art Unit: 3689

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ThuyVi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689